

## REMARKS/ARGUMENTS

The Examiner is thanked for the courteous telephone interview granted Applicants' representative on April 20, 2006. This Response has been prepared pursuant to comments and suggestions made during the interview.

Claims 1-25 are pending in the present application. Claims 1, 9, 10, 11, 14, 16, 19, 20, 21, 23, 24 and 25 are amended. No claims are added and no claims are canceled. Applicants have carefully considered the cited art and the Examiner's comments, and believe the claims patentably distinguish over the cited art in their present form. Reconsideration of the rejection is, accordingly, respectfully requested in view of the above amendments and the following comments.

A new title has been provided as required by the Examiner. Applicants believe the new title is fully descriptive of the claimed invention and respectfully requests that the objection with respect to the title be withdrawn.

Pages 1 and 2 of the specification have been amended as requested by the Examiner to provide the serial numbers of related applications referred to therein.

Claims 1, 9, 14, 19 and 24 have been amended to correct the informalities noted by the Examiner. Informalities noted in claims 10 and 20 have also been corrected. The Examiner is thanked for bringing these errors to Applicants' attention.

### I. 35 U.S.C. § 101

The Examiner has rejected claims 23-25 under 35 U.S.C. § 101 as being directed toward non-statutory subject matter. Applicants respectfully disagree that the claims are directed to non-statutory subject matter. In order to expedite prosecution, however, the claims have been amended to recite "A computer program product in a computer readable, recordable-type medium for processing..." This language is fully supported in the specification at page 64, line 25.

Therefore, the rejection of claims 23-25 under 35 U.S.C. § 101 has been overcome.

### II. 35 U.S.C. § 102, Anticipation

The Examiner has rejected claims 1-2 and 4-25 under 35 U.S.C. § 102(b) as being anticipated by Davidson et al. (U.S. Patent No. 6,446,029). This rejection is respectfully traversed.

In rejecting the claims, the Examiner states as follows:

As per claim 1, Davidson discloses a method in a data processing system for processing instructions, the method comprising: responsive receiving an instruction at a processor in the data processing system, determining whether an indicator is associated

with the instruction (Col. 7 line 64-Col. 8 line 32), wherein the indicator identifies a threshold value (Fig. 5B threshold registers 521-525); and

counting executions of the instruction if the indicator is associated with the instruction and if a time for executing the instruction exceeds the threshold value (Col. 8 lines 61-65).

Office Action dated February 3, 2006, page 4.

Claim 1 of the present application, as amended herein is as follows:

1. A method in a data processing system for processing instructions, the method comprising:

responsive to receiving an instruction at a processor in the data processing system, determining whether an indicator is associated with the instruction, wherein a threshold value is located in the indicator; and

counting executions of the instruction if the indicator is associated with the instruction and if a time for executing the instruction exceeds the threshold value.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single prior art reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of a claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983).

Applicants respectfully submit that Davidson et al. (hereinafter “Davidson”) does not identically show every element of the claimed invention arranged as they are in the claims; and, accordingly, does not anticipate the claims. With respect to claim 1, in particular, Davidson does not teach or suggest “responsive to receiving an instruction at a processor in the data processing system, determining whether an indicator is associated with the instruction, wherein a threshold value is located in the indicator”.

Davidson is directed to a mechanism for monitoring performance of an instruction pipeline. In particular, Davidson discloses monitoring instructions specified to execute within specified threshold time intervals, and counts occurrences of exceeding the threshold intervals. The Examiner refers to threshold registers 521-525 in Fig. 5B and col. 8, lines 61-65 of Davidson in rejecting claim 1. Col. 8, lines 59-66 reads as follows:

Thresholder 520 monitors the stage completion signals and compares the time intervals of each pipeline instruction stage with threshold values stored in threshold registers 521-525. If an instruction pipeline stage requires more time to complete than

indicated by its corresponding threshold value, then thresholder 520 asserts a threshold event signal 526 that is collected by an event counter or multiple event counters 530 in the performance monitor.

As clearly disclosed in the above recitation, in Davidson, a plurality of threshold registers 521-525 store threshold values, and a thresholder 520 compares the stored threshold values with time intervals of each pipeline instruction stage. The threshold values are clearly not located in an indicator associated with an instruction as required by amended claim 1. Davidson, accordingly, does not disclose or suggest “responsive to receiving an instruction at a processor in the data processing system, determining whether an indicator is associated with the instruction, wherein a threshold value is located in the indicator” as recited in claim 1 and does not anticipate claim 1. Claim 1, accordingly, patentably distinguishes over Davidson and should be allowable thereover in its present form, and it is respectfully requested that the Examiner so find.

Claims 2 and 4-8 depend from and further restrict claim 1 and are also not anticipated by Davidson, at least by virtue of their dependency.

Independent claims 9, 11, 16, 19, 21 and 23-25 have been amended in a manner similar to claim 1, and are also not anticipated by Davidson for similar reasons as discussed above with respect to claim 1. Claims 10, 12-15, 17-18, 20 and 22 depend from and further restrict one of claims 9, 11, 16, 19 and 21; and are also not anticipated by Davidson, at least by virtue of their dependency.

Therefore, the rejection of claims 1-2 and 4-25 under 35 U.S.C. § 102 has been overcome.

Furthermore, Davidson does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Davidson actually teaches away from the presently claimed invention because it teaches providing threshold values in a plurality of threshold registers as opposed to locating a threshold value in an indicator associated with an instruction as in the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement Davidson to locate threshold values in an indicator associated with an instruction, one of ordinary skill in the art would not be led to modify Davidson to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify Davidson in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants’ disclosure as a template to make the necessary changes to reach the claimed invention.

### III. 35 U.S.C. § 103, Obviousness

The Examiner has rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Davidson et al. (U.S. Patent No. 6,446,029). This rejection is respectfully traversed.

Claim 3 depends from claim 1, and recites that the threshold value is a three bit value located in the indicator. In rejecting the claim, the Examiner acknowledges that Davidson fails to disclose the subject matter of claim 3, but contends that it would have been obvious to one of ordinary skill in the art at the time of invention to have located the threshold values inside the indicator for the benefit of reduced logic. The Examiner also asserts that using three bits to represent the threshold value would be obvious because “a small amount of logic is needed to represent the value and up to eight different values can be produced”. Applicants respectfully disagree with the Examiner’s conclusions.

A *prima facie* case of obviousness must be supported by some teaching, suggestion, or incentive contained in the prior art which would have led one of ordinary skill in the art to make the claimed invention. The Examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The requirements for establishing a *prima facie* case of obviousness include the requirements that the Examiner explain in detail why an artisan would have found the claimed invention obvious in light of the teachings of the cited prior art, and that the Examiner provide a showing that it is the prior art and not the Applicants’ own disclosure that teaches the modification asserted by the Examiner.

Davidson discloses only that threshold values are stored in threshold registers. Davidson contains no disclosure or suggestion of any kind that threshold values can or should be located in an indicator that is associated with an instruction, and certainly does not disclose or suggest that the threshold value is a three bit value located in the indicator. Only the present application contains such a disclosure and Applicants submit that the Examiner is using hindsight based on Applicants’ own disclosure to modify Davidson in an effort to achieve the present invention. The Examiner, accordingly, has not established a *prima facie* case of obviousness in rejecting claim 3, and claim 3 should be allowable over Davidson in its own right as well as by virtue of its dependency from claim 1.

Therefore, the rejection of claim 3 under 35 U.S.C. § 103 has been overcome.

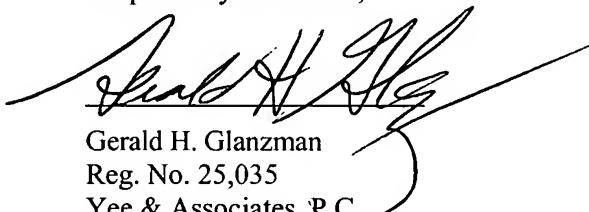
**IV. Conclusion**

For all the above reasons, it is respectfully urged that claims 1-25 are allowable in their present form, and that this application is now in condition for allowance. It is, accordingly, respectfully requested that the Examiner so find and issue a Notice of Allowance in due course.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: May 3, 2004

Respectfully submitted,



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